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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/713,178

11/13/2003

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128 7590 12/19/2006  
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EXAMINER

HEINRICH, SAMUEL M

ART UNIT

PAPER NUMBER

1725

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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2 MONTHS

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PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/713,178  
Filing Date: November 13, 2003  
Appellant(s): BAKER ET AL.

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Paul Amrozowicz  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**  
DEC 19 2006  
**GROUP 1700**

This is in response to the appeal brief filed September 25, 2006 appealing from the Office action mailed February 07, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Evidence relied upon by the examiner in the rejection of the claims under appeal:

JP09057482          Amada Co. LTD.

USPN 2,074,629      Ungar

GB1334772          Messer Griesheim GMBH

JP359087999A      Mitsubishi Electric Corp.

USPN 5,151,095    Teeple, Jr.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-17 and 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP09057482 in view of USPN 2,074,629 to Ungar and in view of GB1334772. Ungar shows a very old and well known shield on a hand tool. GB1334772 shows a shield on a laser tool and the shield surrounds the nozzle.

JP09057482 shows a hand held laser tool which has a shield. The use of a surround-type shield on the hand tool of JP09057482 would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the shields are very old and well known and different shaped shields are known to have been used on a wide variety of apparatus. Positioning of a particularly shaped shield with respect to a tool, for a desired protection, is within the level of skill of one of ordinary skill in the art. The instant claimed intended use(s) of the device does not impart patentability to the device.

Claims 5-11 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP09057482 in view of USPN 2,074,629 to Ungar and in view of GB1334772 as applied to claim 1 above, and further in view of JP359087999A. JP359087999A discloses well known replaceable shields (12C in Figure 1B). The use of replaceable shields is very old and well known. The use of a replaceable shield in the laser tool would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because of ease and economy of replacement of the shield surface. The use of a recess for positive location is well known, for instance in window and frame assemblies.

Claims 12-14, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP09057482 in view of USPN 2,074,629 to Ungar and in view of GB1334772 as applied to claims 1 and 15 above, and further in view of USPN 5,151,095 to Teeple, Jr. Teeple, Jr discloses well known sensor means in a shield. The use of well known sensors in any shield would have been obvious at the time

applicant's invention was made to a person having ordinary skill in the art because the sensors can be used to provide feedback for the user for improving a work task.

**(10) Response to Argument**

Applicant argues that USPN 2,074,629 to Ungar is not analogous art. This argument is not convincing. Ungar shows a very old and well known configuration of a shield on a hand tool. In response to applicant's argument that Ungar is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all references used in the rejection pertain to shields and Ungar shows a particular shape.

Applicant remarks that the instant shield reflects at least a portion of the laser light. Note that at least GB 1,334,772 describes (page 3, column 1, line 4) shield reflection capability.

Applicant argues that JP359087999A is not analogous art. This argument is not convincing. JP359087999A describes a well known shield which is replaceable. In response to applicant's argument that JP359087999A is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all

references used in the rejection pertain to shields and JP359087999A discloses a replaceable shield function.

In response to applicant's argument that the shields disclosed in the prior art have functions other than laser reflection, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's argument that proximity sensors are not configured to sense a proximity of the shield to the work piece, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Note that both JP09057482 and Teeple, Jr. disclose sensors. The use of sensors in shields is very well known.

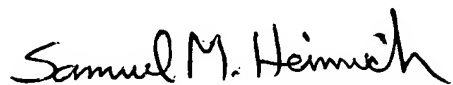
In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Samuel M. Heinrich". The script is cursive and fluid.

Samuel M. Heinrich

Conferees:

Patrick Ryan

A handwritten signature in black ink, appearing to be a stylized "PR".

William Krynski

A handwritten signature in black ink, appearing to be a stylized "WK".